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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/545,991	04/10/2000	Craig Freeman	70764.02	2836

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EXAMINER
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YOUNG, JOHN L

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 12/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. <b>09/545,991</b>	Applicant(s) <b>Freeman</b>
	Examiner <b>John Young</b>	Art Unit <b>3622</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)  Responsive to communication(s) filed on Oct 1, 2002.

2a)  This action is FINAL.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

4)  Claim(s) 15-42 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 15-42 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6)  Other: \_\_\_\_\_

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## **REJECTION (Paper#10)**

### **DRAWINGS**

1. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

### **ABSTRACT OBJECTION—37 CFR 1.72(b)**

2. Applicant is reminded of the proper format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. In this case the abstract contains 214 words. Correction is required. See MPEP § 608.01(b).

### **REQUIREMENT FOR INFORMATION—37 CFR 1.105**

3. The Office requires the submission of such information reasonably necessary to properly examine the instant application:

**Commercial database:** The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention;

**Search:** Whether a search of the prior art was made, and if so, what was searched;

**Related information:** A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention;

**Information used to draft the instant application:** A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application; and

**Information used in invention process:** A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

**NONSTATUTORY DOUBLE PATENTING**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 15-42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,134,557 Freeman "MATERIAL AND SUPPLIES ORDERING SYSTEM" (Oct. 17, 2000) [US f/d: Nov. 20, 1998] (herein referred to as "Freeman '557"). Although the conflicting claims of the instant application are broader and therefore are not identical to the claims at issue in Freeman '557, the

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claims in the instant application are not patentably distinct from the claims at issue in Freeman ‘557, and the if claims in the instant application are allowed, they would improperly extend the right to exclude already granted in Freeman ‘557.

As per claims 15-42, the subject matter claimed in the instant application is fully disclosed in Freeman ‘557.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the “[initiating of] a contractor/customer ordering computer program . . . selects a classification of construction materials or products, the contractor/customer further selecting a set of construction materials or products within the classification . . . [enabling] the contractor/customer to access either a SKU number, a UPC, a bar code, or a material or product number for each individual material or product name selected; and cause data corresponding to the list and data pertaining to contractor/customer identification information entered in to the ordering program to be transferred to the intended supplier. . . .” claim language of the instant application would have been selected in accordance with the “contractor’s/customer’s ordering program . . . entering one or more materials or product names etc. . . .” method of Freeman ‘557 because such selection would have provided means for a “*categorization table [to organize] data under successive and expandable levels of categorized headings, assigns the appropriate vendor specific names, SKU codes, part numbers, universal product code, and/or bar codes, and then transfers this specific information to a merchant or vendor for*

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*processing of the order. . . .” (see Freeman ‘557 (col. 2, ll. 7-12) and see the specification of the instant application (p. 5, ll. 1-5).*

Furthermore, there is no apparent reason why Applicant was prevented from presenting claims corresponding to claims 15- 42 of the instant application during prosecution of the application which matured into the Freeman ‘557 patent. See MPEP § 804.

### **CLAIM REJECTIONS — 35 U.S.C. §103(a)**

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 15-42 are rejected under 35 U.S.C. §103(a) as being obvious over Logica's Integration and Automation of Work Management System Gives SaskEnergy Competitive Advantage," Business Wire 15 September 1997, pp. 1-2) (herein referred to as "Business Wire") in view of Wakiyama 5,806,069 (09/08/1998) (herein referred to as "Wakiyama").

As per claim 15, Business Wire (pp. 1-2) shows elements that suggest the "A contractor/customer ordering computer program product, tangibly embodied on a machine-readable medium, comprising instructions operable to cause a programmable processor to: initiate a contractor/customer ordering computer program. . . ."

Business Wire lacks an explicit recitation of "receive data entered by a contractor/customer in response to a display initiated by the ordering program and identify a specific supplier, corresponding to the data from a plurality of potential suppliers; display a menu from which the contractor/customer selects a classification of construction materials or products, the contractor/customer further selecting a set of construction materials or products within the classification; display a set of specific material or product names corresponding to at least one of the selected construction materials or products, the set of specific material or product names being dependent on the identified supplier such that the set includes only names of specific materials or products that are provided by the identified supplier; in response to the contractor/customer selecting one or more of the displayed specific material or product names and a specific quantity desired for each selected specific material or product name, record the specific material or product name

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and a quantity for each specific material or product name selected; generate a list displaying the specific material or product name and a quantity for each individual specific material or product name selected; enable the contractor/customer to access either a SKU number, a UPC, a bar code, or a material or product number for each individual material or product name selected ; and cause data corresponding to the list and data pertaining to contractor/customer identification information entered into the ordering program to be transferred to the intended supplier.”

Wakiyama (the ABSTRACT; FIG. 8; FIG. 15; FIG. 16; FIG. 19; FIG. 20; FIG. 22; FIG. 26; FIG. 27; FIG. 34; col. 3, ll. 42-50; col. 12, ll. 14-29; col. 9, ll. 57-67; col. 10, ll. 47-67; col. 16, ll. 32-67; col. 17, ll. 1-67; col. 18, ll. 1-67; col. 22, ll. 7-67; col. 23, ll. 1-67; col. 24, ll. 1-67; col. 27, ll. 45-67; col. 28, ll. 35-67; and col. 29, ll. 3-67) shows elements that suggest “receive data entered by a contractor/customer in response to a display initiated by the ordering program and identify a specific supplier, corresponding to the data form a plurality of potential suppliers; display a menu from which the contractor/customer selects a classification of construction materials or products, the contractor/customer further selecting a set o f construction materials or products within the classification; display a set of specific material or product names corresponding to at least one of the selected construction materials or products, the set of specific material or product names being dependent on the identified supplier such that the set includes only names of specific materials or products that are provided by the identified supplier; in

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response to the contractor/customer selecting one or more of the displayed specific material or product names and a specific quantity desired for each selected specific material or product name, record the specific material or product name and a quantity for each specific material or product name selected; generate a list displaying the specific material or product name and a quantity for each individual specific material or product name selected; enable the contractor/customer to access either a SKU number, a UPC, a bar code, or a material or product number for each individual material or product name selected ; and cause data corresponding to the list and data pertaining to contractor/customer identification information entered into the ordering program to be transferred to the intended supplier.”

Wakiyama proposes “supplier identification” and specific product number and part name, stock keeping unit (SKU) universal product code [UPC] or bar code for each material or product modifications that would have applied to the system of Business Wire. It would have been obvious to a person of ordinary skill in the art the time of the invention to combine the teachings of Business Wire with the disclosure of Wakiyama because such combination would have provided “*a method of totally managing construction-related information and production-related information with improved efficiency. . .*” (see Wakiyama (col. 1 ll. 60-65)) and because such combination would have provided means “*to both automate all traditional ‘paper-based’ processes across a wide area client/server network, and to integrate centralized engineering and*

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*construction management functions with decentralized customer service delivery. . . .”*  
(see Business Wire (p. 1, ll. 8-13)).

As per claim 16, Business Wire in view of Wakiyama shows the program of claim 15. (See the rejection of claim 15 supra).

Business Wire (pp. 1-2) shows elements that suggest transferring the list and data pertaining to contractor/customer identification information elements and limitations of claim 16.

Business Wire lacks an explicit recitation of the transferring elements and limitations of claim 16, even though Business Wire (pp. 1-2) suggests same.

Wakiyama (the ABSTRACT; FIG. 19; col. 9, ll. 57-67; col. 10, ll. 47-67; col. 16, ll. 32-67; col. 17, ll. 1-67; col. 18, ll. 1-67; col. 22, ll. 7-67; col. 23, ll. 1-67; col. 24, ll. 1-67; col. 27, ll. 45-67; col. 28, ll. 35-67; and col. 29, ll. 3-67) shows elements that suggest the transferring elements and limitations of claim 16.

Wakiyama in view of Business Wire proposes transferring modifications that would have applied to the system of Business Wire. It would have been obvious to a person of ordinary skill in the art the time of the invention to combine the teachings of Business Wire with the disclosure of Wakiyama because such combination would have provided “*a method of totally managing construction-related information and production-related information with improved efficiency. . . .*” (see Wakiyama (col. 1 ll.

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60-65)) and because such combination would have provided means “*to both automate all traditional ‘paper-based’ processes across a wide area client/server network, and to integrate centralized engineering and construction management functions with decentralized customer service delivery. . .*” (see Business Wire (p. 11. 8-13)).

As per claims 17-27, Business Wire in view of Wakiyama shows the program of claim 15. (See the rejection of claim 15 supra).

Business Wire (pp. 1-2) shows elements that suggest the elements and limitations of claims 17-27.

Business Wire lacks an explicit recitation of the elements and limitations of claims 17-27, even though Business Wire suggests same.

“Official Notice” is taken that both the concepts and the advantages of the elements and limitations of claims 17-27 were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided “*a method of totally managing construction-related information and production-related information with improved efficiency. . .*” (see Wakiyama (col. 1 ll. 60-65)) and because such combination would have provided means “*to both automate all traditional ‘paper-based’ processes across a wide area client/server network, and to integrate centralized engineering and construction management functions with decentralized customer service delivery. . .*” (see Business Wire (p. 11. 8-13)).

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Independent claim 28 is rejected for substantially the same reasons as claim 15.

Dependent claims 29-40 are rejected for substantially the same reasons as claims 16-27 respectively.

Independent claim 41 is rejected for substantially the same reasons as claim 15.

Dependent claim 42 is rejected for substantially the same reasons as claim 27.

### **RESPONSE TO COMMENTS**

6. The rejections of claims 1-14 of the prior Office Action are not withdrawn but are moot based upon Applicant's cancellation of said claims.

### **CONCLUSION**

7. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

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Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or

(703) 746-7239 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh floor Receptionist  
Crystal Park V  
2451 Crystal Drive  
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
John L. Young  
Patent Examiner

(Partial Signatory Authority)

December 5, 2002